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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/679,806	10/06/2003	Wen-Feng Liu	P26,257-C USA	3311

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EXAMINER

ASINOVSKY, OLGA

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 07/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/679,806

Applicant(s)

LIU ET AL.

Examiner

Olga Asinovsky

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 14-51 is/are pending in the application.
- 4a) Of the above claim(s) 16-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14, 15 and 23-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 03/29/2006
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Applicant's election without traverse of Group I, claims 1-15 in the reply filed on January 21, 2005 is acknowledged.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 02/2006 has been entered.

Applicants amend claim 1 by including that "an adhesive composition has a pull out performance after one hour at a temperature of 23 C of at least about 70 KN."

Upon reviewing the present claims together with applicants' argument, claims 35-41 and 43-49 are rejoined.

The present claims 1-12, 14-15 and 23-51 are under examination.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

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1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. The rejection was set in the previous office action mailed on 10/26/2005, and it is incorporated here.

2. Claims 1-12, 14-15 and 23-51 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-45 of copending Application No. 10/679,871 (Pub. No. US 2004/0127680) in view of Parish et al U.S. Patent 5,891,942. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications recite a curable adhesive composition comprising polymerizable vinyl ester comprising the reaction product of a compound containing an ethylenically unsaturated group with epoxy compound, curing catalyst and an activator. A pull out performance for the adhesive composition is readable in claims 13-45 of Application No. 10/679,871.

3. The difference is that the present claims include reactive multifunctional acrylate. A multifunctional acrylate is a polymerizable compound.

4. Parish discloses a multifunctional compound that has a benefit to increase the crosslink density of the coating, col. 3, line 56. It would have been obvious to one of ordinary skill in the art to expect the presence of said multifunctional acrylate in a curable adhesive composition in claims 1-45 of Application No. 10/679,871 to increase

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adhesive properties of the adhesive composition, support of that can be found in Parish' 5,891,942 at col. 3, line 56.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 1-12, 14-15, 23-51 are provisionally rejected under 35 U.S.C. 103(a) as being obvious over copending Application No. 10/679,871 (Pub.No.: US 2004/0127680) which has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e) if published or patented. This provisional rejection under 35 U.S.C. 103(a) is based upon a presumption of future publication or patenting of the conflicting application. See explanation in the paragraphs 3-4 above. Also, a multifunctional acrylate is readable in the disclosure of the Pub. No. US 2004/0127680 at page 4 [0056].

This provisional rejection might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by a showing of a date of invention for the instant application prior to the effective U.S. filing date of the copending application under 37 CFR 1.131. This rejection might also be overcome by showing that the copending application is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-5, 9-12, 14-15, 23-26, 30-41, 45-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0 875 546.

8. EP 0875546 discloses an acrylate-based composition including a resin component such as vinyl esters or vinyl polyesters; at least one reactive diluent such as a vinyl toluene; multifunctional acrylates such as trifunctional acrylates; a catalyst=curing catalyst; an accelerating agent and an activating agent: column 2, lines 54-58; column 3, lines 1-2, 11, 15 and 23; column 4, lines 27-34, 47-58; column 5, lines 14-20, 27-41; column 6, lines 15-18, 51-58. A multifunctional acrylate can be present in the range of 1 to 30wt.%, claim 1 at column 8. All ingredients in a curable acrylate-based coating composition in EP'546 are readable in the present claims. EP'546 discloses a sprayable coating composition for forming a cured coating onto a substrate. The coating composition cures at room temperature, column 8, lines 12-15. The adhesive properties are inherent to the cured coating composition in EP'546 invention.

9. The difference between the present claims and EP'546 invention is that EP'546 does not disclose claimed "pull out performance after one hour at a temperature of 23 C of at least about 70 KN".

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10. It would have been obvious to one of ordinary skill in the art to consider that the analogous chemical formulated composition in EP'546 will produce the same pull out performance in the absence of evidence to the contrary. The prima facie case of obviousness is that the curing performance and adhesive properties are depending on the curing catalyst system including catalyst, activator, an accelerating agent and/or promoter; and since any curing catalyst and an activator are readable in the present, the pull out performance in EP'546 would be readable in the present claims.

11. Claims 6-8, 27-29, 42-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0 875546 as applied to claims 1-5, 9-12, 14-15, 23-26, 30-41 and 45-51 above, and further in view of Yonetani et al U.S. Patent 6,015,845 or Nakamura et al U.S. Patent 6,489,396.

EP'546 does not disclose polymerizable vinyl ester comprising the reaction product of an epoxy compound and a compound containing an ethylenically unsaturated group in the present claims 8 and 29. Also, EP'546 does not disclose a tetra-functional acrylate.

Yonetani discloses a binder based on an epoxy acrylate resin diluted with a reactive monomer. The epoxy acrylate resin is prepared by adding methacrylic acid to a bisphenol A type epoxy resin.

It would have been obvious to one of ordinary skill in the art to substitute a polymeric resin based on vinyl esters or vinyl polyesters in EP'546 invention with an epoxy acrylate resin in Yonetani invention for the purposes of obtaining the claimed

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requirement, since each resin component such as based on vinyl esters or vinyl polyester in EP'546 and an epoxy acrylate resin in Yonetani invention works within the same expectation of being a curable resin. There is no showing of unexpected results derived from said substitute.

Nakamura discloses multifunctional polymerizable unsaturated monomers including pentaerythritol tetraacrylate, column 9, lines 8-9.


It would have been obvious to one of ordinary skill in the art to use a polymerizable tetrafunctional acrylate as disclosed in Nakamura invention for being a multifunctional acrylate in EP'546 since any multifunctional acrylate works within the same expectation. There is no showing of unexpected results derived from said use.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olga Asinovsky whose telephone number is 571-272-1066. The examiner can normally be reached on 9:00 to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


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